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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,589	03/10/2004	Matthew D. Nordstrom	005127.00288	4718

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BANNER & WITCOFF, LTD.
28 STATE STREET
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BOSTON, MA 02109-1701

EXAMINER

WORRELL JR, LARRY D

ART UNIT	PAPER NUMBER
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3765

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/797,589	Applicant(s) NORDSTROM, MATTHEW D.	
	Examiner Danny Worrell	Art Unit 3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The recitation “substantially an entire interior surface of the swimsuit body is in contact with the swimmer’s body when the swimsuit body is worn by a user” was not set forth in the application as filed and as such is new matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 7-11, 15, 19, 21, 22, 26-29 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Doerschuk et al (US 4365351).

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The disclosure of Doerschuk et al (US 4365351) teaches the invention as claimed including an article of swimwear comprising, in combination: a swimsuit body (10) having at least one aperture (neck and arms) configured to encircle a portion of a swimmer's body when the swimsuit body is worn by a user; a resilient seal (20, 22) having an interior surface, first portion of the interior surface secured about the at least one aperture on an exterior of the swimsuit body and a second portion of the interior surface extending beyond the swimsuit body and configured to contact the user's body when the swimsuit body is worn by the user. Note an adhesive in the form of tape (42) is used to secure the seal. Concerning the recitation "configured to be stretched over a swimmer's body so as to provide a conforming fit on a swimmers body", as broadly recited the swimsuit body of Doerschuk is stretched over a swimmer's body to provide a conforming fit on a swimmer's body to as seen at least in the chest covering portion of figure 2 and the waist covering portion of figure 5. The term "stretch" reasonably encompasses extending, spreading, or placing something. Concerning the additional language of "such that the entire swimsuit body provides a conforming fit", the entire swimsuit of Doerschuk does provide a conforming fit given the bendable, flexible, pliable nature of the swimsuit body. The term "conforming" reasonably includes the act of making similar in form, nature, character or bringing into agreement, correspondence, or harmony. Undoubtedly the entire swimsuit of Doerschuk provides such a conforming fit. Concerning the recitation, "wherein an exterior surface of the resilient seal is completely exposed to an exterior of the swimsuit body", as is evidently seen in figures 2 and/or 5, multiple exterior surfaces including at least an upper, lower and side exterior surface are exposed to an exterior of the swimsuit body. The added recitation, "substantially an entire interior surface of the swimsuit body is in contact with the swimmer's

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body when the swimsuit body is worn by a user”, is considered new matter. Nonetheless, an entire interior surface of the Doerschuk swimsuit contacts a wearer’s body as broadly recited given that the Doerschuk suit fits over the wearer’s body and is in no way held away from the body. Furthermore given the bendable, flexible, pliable nature of the swimsuit body as noted above, it is reasonable to assume that substantially an entire interior surface of the suit would contact a swimmer’s body at some point while being worn. Moreover, the fit of the suit is dependant on the size of the wearer relative to the swimsuit size.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, 6, 9-11, 13, 19-25, 28, 29, 31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman (6088832) in view of Doerschuk et al (US 4365351). Newman (6088832) teaches the invention as claimed including an article of swimwear comprising, in combination: a swimsuit body (10) having at least one aperture (24-27) configured to encircle a portion of a swimmer’s body when the swimsuit body is worn by a user; a resilient seal (31) having a first portion (back face 33) secured about the at least one aperture and a second portion (front face 32) extending beyond the swimsuit body and configured to contact the user’s body when the swimsuit body is worn by the user. Note that the strip is attached by adhesion or stitching. Note that the seal encircles waist and legs. However, the seal

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of Newman is set forth on an interior of the swimsuit body rather on an exterior of the swimsuit body. The disclosure of Doerschuk et al (US 4365351) shows an alternative mounting system for mounting resilient seals on an exterior of a swimsuit. It would have been obvious at the time the invention was made to provide the mounting of the seal of Newman as an exterior mount as shown by Doerschuk et al (US 4,365,351) since such is a well known alternative mounting structure and in order to have unfettered access to the seal while the suit is being worn so that the seal can be visually inspected for wear and/or replaced. Concerning the recitation “configured to be stretched over a swimmer’s body so as to provide a conforming fit on a swimmers body”, as broadly recited the swimsuit body of Newman is stretched over a swimmer’s body to provide a conforming fit on a swimmer’s body. The term “stretch” reasonably encompasses extending, spreading, or placing something. Concerning the additional language of “such that the entire swimsuit body provides a conforming fit”, the entire swimsuit of Newman does provide a conforming fit given the bendable, flexible, pliable nature of the swimsuit body. The term “conforming” reasonably includes the act of making similar in form, nature, character or bringing into agreement, correspondence, or harmony. Undoubtedly the entire swimsuit of Newman provides such a conforming fit as broadly recited. Concerning the recitation, “wherein an exterior surface of the resilient seal is completely exposed to an exterior of the swimsuit body”, as is evidently seen in figures 2 and/or 5 of Doerschuk’s alternate seal mounting structure, multiple exterior surfaces including at least an upper, lower and side exterior surface are exposed to an exterior of the swimsuit body. The added recitation, “substantially an entire interior surface of the swimsuit body is in contact with the swimmer’s body when the swimsuit body is worn by a user”, is considered new matter. Nonetheless, an entire interior surface of the

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Newman swimsuit contacts a wearer's body as broadly recited given that the Newman suit fits over the wearer's body and is in no way held away from the body. Furthermore given the bendable, flexible, pliable nature of the swimsuit body as noted above, it is reasonable to assume that substantially an entire interior surface of the suit would contact a swimmer's body at some point while being worn. Moreover, the fit of the suit is dependant on the size of the wearer relative to the swimsuit size.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 7, 8, 12, 14-18, 26, 27, 30, 32 and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman (6088832) in view of Doerschuk et al (US 4365351).

The combined disclosures of Newman and Doerschuk et al (US 4365351) teach the invention as claimed as set forth above in the rejection to claim 1. They do not teach welding for securing the seal to the swimsuit. The examiner takes Official Notice that it is well known to secure garment elements via welding. Therefor it would have been at the time the invention was

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made to substitute welding for stitching or adhesive for securing the seal to the garment since any of these would provide an equivalent securing function. Concerning the specific location of the seal as encircling the arm and neck of the user, it would have been obvious to provide the seal at both a neck portion and arm portion in order to prevent water from entering the swimsuit at such locations. Concerning the specific swimwear style of extending to the ankles, it would have been obvious to provide choose from a number of different swimwear styles including those which extend to the ankles in order to find the style which covers various portions of a users body as required for a specific swimming activity.

Response to Arguments

Applicant's arguments with respect to claims 1-36 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danny Worrell whose telephone number is 571/272-4997. The examiner can normally be reached on MONDAY-THURSDAY.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, GARY WELCH can be reached on 571/272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Danny Worrell/
Primary Examiner, Art Unit 3765